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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054980
Party	Defendant Paisanos Pasta, LLC
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Date	09/04/2012
Attachments	Opposition to Mtn to Extend Disc Period 20120904.pdf (9 pages)(368675 bytes)

In the matter of U.S. Trademark Registration No. 3,553,382

Cancellation No. 92054980

COMES NOW Registrant Paisanos Pasta's ("Registrant") opposition to Petitioner Andoni, Inc.'s ("Petitioner") First Motion for Extension of Discovery and Testimony Periods. This opposition is supported by the Declaration of Bradley J. Levang ("Levang Dec.") submitted concurrently herewith.

I. Factual Background.

On March 8, 2012, the discovery period in the above-captioned cancellation proceeding opened. Levang Dec. ¶ 4.

On June 29, 2012, Registrant served Petitioner with a first set of Interrogatories and a Request for Production of Documents (collectively “Discovery Requests”). Levang Dec. ¶ 5.

On July 31, 2012, Petitioner’s counsel contacted Registrant’s counsel seeking an extension of time to provide responses to the Discovery Requests. Levang Dec. ¶ 6. The parties agreed that Petitioner would have until August 10, 2012 to provide responses to the Discovery Requests. Id.

The deadline to disclose experts was on August 5, 2012. Levang Dec. ¶ 7. Neither Petitioner nor Registrant have disclosed any experts, or have served any expert disclosures on the other party. Levang Dec. ¶ 7.

On August 9, 2012 Petitioner’s counsel again contacted Registrant’s counsel seeking a further extension of time to provide responses to the Discovery Requests. Levang Dec. ¶ 8.

On August 10, 2012, the parties agreed that Petitioner would have until August 24, 2012 to provide responses to the Discovery Requests. Levang Dec. ¶ 9.

On August 24, 2012, Petitioner’s counsel contacted Registrant’s counsel via telephone and represented that Petitioner did not have responses to the Discovery Requests. Levang Dec. ¶ 10.

In each of its requests for an extension of time, Petitioner has offered Registrant an equal amount of time in which to respond to the discovery propounded by Petitioner. Levang Dec. ¶

11. Registrant's responses to Petitioner's discovery requests (served on July 13, 2012) are not due until September 10, 2012. Levang Dec. ¶ 12.

Petitioner has not set forth any facts as to any actions on Registrant's part that have hampered or delayed Petitioner's discovery efforts, or lack thereof.

Registrant takes issue with Petitioner's abbreviated description of the settlement negotiations. On August 10, 2012, counsel for Petitioner and Registrant discussed the issue of settlement. Levang Dec. ¶ 13. That same day, Registrant proposed a settlement offer to Petitioner. Id. Not until August 22, 2012, did Petitioner send a counter offer in the form of a first proposed Settlement Agreement. Levang Dec. ¶ 14. Almost every business day since then, the parties have been sending offers and counter-offers back and forth. Levang Dec. ¶ 15. While Registrant agrees with Petitioner that the parties have been working toward settlement and they appear to be getting closer, a final settlement agreement has yet to be reached. Levang Dec. ¶ 16. Indeed, even as late as August 31, 2012, counsels for the parties were still trying to achieve a "meeting of the minds" regarding some of the more significant points of settlement. Levang Dec. ¶ 17. As of September 4, 2012, the parties are hopeful about finalizing a settlement, but settlement is still not certain or guaranteed. Levang Dec. ¶ 18.

On September 4, 2012, the discovery period in this case closes. Levang Dec. ¶ 19.

On September 4, 2012, Petitioner filed its Motion for Extension of Discovery and Testimony Periods. Levang Dec. ¶ 20.

II. Law and Argument

Registrant opposes Petitioner's Motion because Petitioner has not set forth with particularity the facts that constitute good cause for the requested extension, as required by Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 509.01(a). see, SFW Licensing Corp. v. Di Pardo Packing Ltd., 60 USPQ2d 1372, 1373 (TTAB 2001) (opposers had not come forward with "detailed facts" required to carry their burden explaining their inaction); Luemme, Inc. v. D. B. Plus Inc., 53 USPQ2d 1758 (TTAB 1999) (sparse motion contained insufficient facts on which to find good cause); and Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719, 1720 n.3 (TTAB 1989) ("The presentation of one's arguments and authority should be presented thoroughly in the motion or the opposition brief thereto."). The Board must "scrutinize carefully" any motion to extend time, to determine whether the requisite good cause has been shown. TBMP § 509.01(a). Further, "a party moving to extend time must demonstrate that the requested extension of time is not necessitated by the party's own lack of diligence or unreasonable delay in taking the required action during the time previously allotted therefor." Id. In the present instance, Petitioner has not set forth any explanation, much less a factual one, as to why it has undertaken essentially no discovery in the present case, and therefore now, on the last day of the discovery period, it requests additional time.

A. Petitioner has Not Established Good Cause to Extend the Discovery and Testimony Periods.

"[M]ere delay in initiating discovery does not constitute good cause for an extension of the discovery period." Luemme Inc. v. D.B. Plus Inc., 53 USPQ2d 1758 (TTAB 2000).

Petitioner has not set forth any factual basis for taking no discovery from the time discovery opened on March 8, 2012 until it propounded its first set of discovery requests on July 13, 2012. Nor has Petitioner explained its delay in pursuing any further discovery from July 13, 2012 until September 4, 2012. Id. at 1760-1761 (TTAB 1999) (plaintiff failed to set forth detailed facts concerning the circumstances -- plaintiff's allegedly busy travel schedule -- which necessitated the extension, and record showed that need for extension in fact resulted from plaintiff's delay and lack of diligence during previously-set discovery period); National Football League v. DNH Management LLC, 85 USPQ2d 1852 (TTAB 2008) (opposers' motion to extend discovery period denied where opposers did not serve written discovery requests until final day of discovery, and did not attempt to depose applicant during prescribed discovery period, and evidence does not support opposers' claim that they delayed discovery because parties were engaged in settlement discussions); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303, 1305 (TTAB 1987) (no reason given why discovery was not taken during the time allowed).

Further, Petitioner has set forth no facts as to how settlement discussions have impacted its ability to conduct discovery. Settlement discussions alone do not qualify as good cause to extend the discovery period. See generally, Fairline Boats plc v. New Howmar Boats Corp., 59 USPQ2d 1479, 1480 (TTAB 2000) (motion to extend testimony filed on last day with vague references to settlement would not justify delay in proceeding with testimony); Instruments SA Inc. V. ASI Instruments, Inc., 53 USPQ2d 1925, 1927 (TTAB 1999) (plaintiff's claim of ongoing bilateral settlement negotiations was rebutted by defendant, and no other reason for plaintiff's failure to proceed with discovery was shown).

Further, throughout the discussion of possible settlement, Registrant has never excused Petitioner from its discovery obligations. In fact, Registrant has raised the issue of the tardy

responses to the Discovery Requests with Petitioner's counsel by telephone conference on August 24, 2012, and has sent e-mails to Petitioner's counsel on August 28, 29, and 30, 2012 regarding the outstanding discovery. Levang Dec. ¶¶ 21, 22. On August 29, 2012, Registrant sent an e-mail to Petitioner's counsel indicating that Registrant would file a motion to compel if responses to the Discovery Requests were not received by August 31, 2012. Levang Dec. ¶ 23.

Further, this Board should not allow for Petitioner to extend the discovery period when Petitioner, itself, refuses to participate in the discovery process. As of the filing of Petitioner's request to extend the discovery period, Petitioner has had about 68 days to provide responses to the Discovery Requests, but has not produced any responses whatsoever. Further, Petitioner is about 12 days past the latest extension of time to provide discovery responses to the Discovery Requests and has not provided any responses. It is manifestly unjust for Petitioner to actively hamper Registrant's discovery efforts during the discovery period, then turn around and, on the last day of the discovery period, seek more time from the Board for Petitioner to conduct discovery.

Petitioner has had more than enough time to investigate the allegations in the Petition for Cancellation, a Petition which the Petitioner itself brought. Petitioner has not stated any factual basis for being unable to undertake discovery in this proceeding. Further, Petitioner has not set forth any facts as to how Registrant has hampered its discovery efforts, because Registrant has not done so. However, Petitioner has hampered Registrant's discovery efforts by completely failing to provide any response at all to the outstanding Discovery Requests propounded by Registrant. Therefore, the Board should deny Petitioner's motion in its entirety. However, should the Board be inclined to grant Petitioner's motion, then Registrant requests, in the

alternative, that the extension of the discovery and testimony period be for a shorter time, such as 14 days.

B. Registrant Requests Extension of the Discovery Period Only as to Registrant.

Registrant respectfully requests that the Board extend the discovery period only as to Registrant to allow for the opportunity to take “follow-up” discovery. As stated in the TBMP:

“At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto... deprive its adversary of the opportunity to take “follow-up” discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion.”

TBMP § 403.04.

As set forth above, Petitioner has failed to provide any responses to the Discovery Requests by the deadline of August 24, 2012. Petitioner has failed to meet its discovery obligations to the detriment of Registrant. Accordingly, Registrant requests that the Board deny Petitioners motion to extend the discovery period, but provides only Registrant, with a 30-day “follow-up” discovery period until October 4, 2012, or any other amount of time which the Board deems just.

C. The Board Should Not Reset the Deadline for Expert Disclosure.

As set forth in TBMP § 403.04 “...if the time for serving expert disclosures has passed and it is clear from the record that such expert disclosures have been served or the parties have made it clear that they do not intend to use experts, the Board may not reset the time for expert disclosures.” TBMP § 403.04

If the Board grants Petitioner's request to extend the discovery period, Registrant requests that any such extension does not reset or reopen any deadlines regarding expert disclosure. The deadline to disclose experts was on August 5, 2012. Neither Petitioner nor Registrant have disclosed any experts, or served any expert disclosures on the other party. Moreover, Petitioner has not indicated any express or implied intent to disclose experts in this case. Consequently, the Board should not reset the deadline for expert disclosure, as it is clear from the record that no expert disclosures have been served and that the parties do not intend to do so.

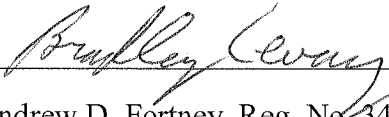
III. Conclusion.

For the foregoing reasons, Registrant respectfully requests that the Board:

- 1) Deny Petitioner's First Motion for Extension of Discovery and Testimony Periods, or
- 2) In the alternative, if the Board grants Petitioner's First Motion for Extension of Discovery and Testimony Periods, that the Board grant the extension for a more reasonable period of time, such as 14 days, and keep the period for expert disclosure closed; and
- 3) Extend the discovery period only as to Registrant to allow for the opportunity to take "follow-up" discovery.

Dated: September 4, 2012

By: _____


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CERTIFICATE OF SERVICE


The undersigned certifies that based on agreement by the parties to accept service by electronic transmission, a copy of **Paisanos Pasta, LLC's Opposition to Petitioner's First Motion for Extension of Discovery and Testimony Periods** was served on Andoni, Inc. on September 4, 2012, by being sent via electronic mail, as well as the original being sent by first class mail with postage prepaid, and addressed to Andoni, Inc.'s attorney of record as follows:

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Walter E. Kubitz
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Dated: September 4, 2012

By: _____


Bradley J. Levang